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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,456	09/02/2004	Pierre Matz	258194US0PCT	1788
22850	7590	11/02/2006	EXAMINER	
C. IRVIN MCCLELLAND		OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.	SCHATZ, CHRISTOPHER	
1940 DUKE STREET		ALEXANDRIA, VA 22314	ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/505,456	MATZ ET AL.
	Examiner	Art Unit
	Christopher T. Schatz	1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 August 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/8/04</u>   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of the restriction in the reply filed on October 12, 2006 is acknowledged. Applicant arguments have been considered but are not found persuasive.

Applicant is respectfully notified that whether a search burden on the examiner exists has no bearing on whether or not an application is appropriate for restriction when said application is filed under 35 U.S.C. 371, MPEP 1893.03(d).

Examiner asserts that under PCT rules a product and a process specifically adopted for manufacture of said product only have Unity of Invention if there is "special technical feature" shared between the product and process. A "special technical feature" is defined as a contribution over the prior art. There is lack of Unity of Invention this case because the shared technical features of Group I and Group II are known, and thus said technical features are not "special technical features" and restriction is appropriate. Applicant is respectfully notified that a tube is not one of the special technical features because claim 1 does not require the support be a tube. Evidence that said shared technical features are known can be found in Foglia et al. '291. Applicant is respectfully referred to MPEP 1893.03(d) and MPEP 1850. Claims 8-10 are withdrawn as being directed to a non-elected invention.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Foglia et al. '291.

Foglia et al. discloses a process for assembling multilayer tape, comprising fusion bonding tape by means of electromagnetic radiation, the tape comprising at least one plastic layer, which is oriented in at least one direction (column 2, line – 3, line 10) and is transparent to the radiation, and at least one layer that partially absorbs energy transported by the radiation, wherein one face of at least one tape of the assembly is fusion-bonded to a plastic preformed support. Specifically, applicant is referred to column 4, lines 3-9. The reference discloses three “films.” The reference further discloses that two the films comprise absorbing layers separate from the transparent layer. These radiation absorbing coatings are discussed in column 3, line 60 – column 4, line 2. Examiner asserts that the disclosed film in combination with the disclosed absorbent coating read on the term “tapes” as currently recited in claim 1 and the last (bottom) film reads on the term “support.” Foglia et al. fully anticipates claim 1 as currently written. As to claim 2, Foglia et al. discloses a method wherein at least two tapes are fusion bonded (figures 5 and 6). As to claim 3, Foglia et al. discloses a method wherein at least one of the tapes in oriented in a single direction (column 4, line 6). As to claims 4 and 5 Foglia et al. discloses a method wherein the radiation comprises laser radiation is between 700 and 1200 nm (column 4, lines 44-51).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greig (GB 2276584) in view of Foglia et al.

Greig discloses a process for assembling multilayer tape, comprising fusion bonding tape by means of electromagnetic radiation, the tape comprising at least one plastic layer, which is transparent to the radiation, wherein one face of at least one tape of the assembly is fusion-bonded to a plastic preformed support (pages 5-9, figure 2). Greig is silent as to a method wherein said tape comprises a transparent oriented layer and partially transparent layer. Foglia discloses a method of fusion bonding two thermoplastic tapes together, and discloses that two multilayer tapes each with a transparent and partially transparent layer (figures 5 and 6) can be fusion bonded together with electromagnetic radiation as an alternative to bonding two single layer tapes together (figures 2 and 3). Use of a two layered tape improves the quality of the fusion bond (column 3, line 60 – column 4, line 9). Foglia et al. also discloses the using an oriented layer increases said layers capacity to selectively absorb electromagnetic radiation (column 2, lines 61-70). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Greig's method such that the tapes 12 and 14 are multilayer tapes with one transparent oriented layer and one partially transparent layer as taught

by Foglia et al. above. Such a modification would improve the fusion bond between the tapes and improve the bond between tape 12 and pipe 10.

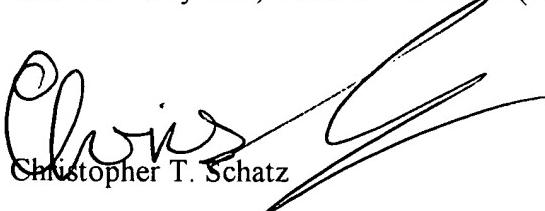
Foglia et al. discloses the limitations of claims 2-5 as discussed above. As to claim 6, Greig discloses a method wherein the plastic preformed support is an unoriented tubular support. As to claim 7, Greig discloses a method wherein the absorbing material is carbon black (page 6).

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Christopher T. Schatz** whose telephone number is **571-272-1456**. The examiner can normally be reached on 8:00-5:30, Monday -Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Christopher T. Schatz



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